



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 2, 6, 11, 12, 20, 32 and 45 of the morning section and questions 3, 6, 9, 13, 33 and 37 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On August 7, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional two (2) points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional two (2) points on the Examination. No credit has been awarded for morning questions 2, 6, 20, 32, and 45, and afternoon questions 3, 6, 9, 13, 33, and 37. Petitioner's arguments for these questions are addressed individually below.

Morning question 2 reads as follows:

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

- (A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.
- (B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.
- (C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.
- (D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.
- (E) (B) and (D).

2. The model answer: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30

days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

Petitioner argues that answer (B) is correct. Petitioner contends that Pete would mail the information disclosure statement at the earliest time possible after September 3, 2001, which would meet 37 CFR 1.704(d) and also meet 37 CFR 1.97(d), and that the patent term adjustment would be reduced since Pete would act quickly. Petitioner contends that all indications would lead one to believe that Pete would respond at the earliest possible time.

Petitioner's arguments have been fully considered but are not persuasive. Answer (B) provides that the applicant may wait until the last day of the three month period to submit the information disclosure statement, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Petitioner's arguments regarding whether Pete, who is determined to take no chances with the application, would in any case mail the information disclosure statement at the earliest time possible, whether or not he is permitted three months from the date cited by the foreign office, are not persuasive. The question provides a list of alternatives from which Pete can choose in order to achieve the client's objectives. None of the answers provided, including answer (B), state that Pete will choose the earliest possible time within the three month period. Petitioner has erroneously interjected assumptions that are not called for by the question. Note that the directions to the morning and afternoon sections state, in part: "Do not assume any additional facts not presented in the questions." The question asks "Which of the following alternatives would *best* achieve the client's objectives. . ." (emphasis added). Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 6 reads as follows:

6. Applicant Jones filed a request for a first continued prosecution application (CPA) on December 29, 2000 in a utility application that was filed on April 28, 2000. Jones received a final Office action mailed on June 28, 2001. In response, Jones filed an amendment amending the claims in the first CPA. Jones received an advisory action on September 27, 2001 stating that the proposed amendment to the first CPA would not be entered because it raises new issues that would require further consideration.

Additionally, the proposed amendment did not meet the requirements for a complete reply under 37 CFR 1.111. On December 28, 2001, Jones filed a petition for a 3-month extension of time with appropriate petition fee, a request for a second continued prosecution application, a request for suspension of action, and appropriate processing fee for the request for suspension of action. No application filing fee was filed with the request for the second CPA. Which of the following would be a proper communication mailed by the Office based on Jones' actions?

- (A) A Notice of Allowability.
- (B) A Notice to File Missing Parts.
- (C) A first Office action on the merits.
- (D) A notice of improper Request for Continued Examination (RCE) and a notice of abandonment.
- (E) A letter granting the suspension of action.

6. The model answer: The most correct answer is (D). See MPEP § 706.07(h), page 700-71, under "IV. IMPROPER CPA TREATED AS RCE." The request for a second CPA filed on December 28, 2001 is improper because the application in which the CPA was filed in has a filing date of December 29, 2000 and is not eligible for the CPA practice. The CPA practice does not apply to applications that have a filing date on or after May 29, 2000. The Office will automatically treat the improper request for a CPA as a Request for Continued Examination under 37 C.F.R. § 1.114. However, the request for a CPA filed on December 28, 2001 does not satisfy the requirements of 37 C.F.R. § 1.114 to be a proper RCE because it lacks the filing fee required by 37 C.F.R. § 1.17, and the required submission under 37 C.F.R. § 1.114. Therefore, the improper CPA will be treated as an improper RCE and the time period set in the last Office action mailed on June 28, 2001 will continue to run. Since the time period expired on December 28, 2001, the application is abandoned. Answers (A), (B), and (C) are incorrect because the request for a second CPA filed on December 28, 2001 is improper and the amendment was not entered. Answer (E) is incorrect because a request for a suspension of action will not be granted if the CPA or the RCE is improper (*e.g.*, a filing date was not accorded in the CPA or the

RCE was filed without a submission). See 37 C.F.R. § 1.103, MPEP § 709, page 700-113.

Petitioner argues that answer (C) is correct. Petitioner contends that because the request for the second CPA filed on December 28, 2001 was improper and the amendment was not entered, a first Office Action on the merits is appropriate. When Jones raised new issues in the first CPA and the examiner only replied with an advisory action, petitioner contends that the examiner may now reasonably send a first Office Action on the merits.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the examiner may now reasonably send a first Office Action on the merits, a notice of improper Request for Continued Examination (RCE) and a notice of abandonment should be mailed. Jones had received a *final* Office action. Prosecution in the first CPA was therefore closed. In response, Jones filed an after-final amendment which raised new issues that would require further consideration. The examiner properly mailed an advisory action explaining why the proposed amendment would not be entered. Jones then filed a request for the second CPA. However, as stated above, the request for a second CPA is improper because the application in which the second CPA was filed in has a filing date of December 29, 2000 and is not eligible for the CPA practice (noting that the application is accorded the filing date of the first CPA, since a CPA is considered a new application and is accorded a new filing date). The CPA practice does not apply to applications that have a filing date on or after May 29, 2000. While the Office automatically treats an improper request for a CPA as a Request for Continued Examination (RCE) under 37 CFR 1.114, the improper request for a second CPA will be treated as an *improper* RCE because the request lacks the filing fee for the RCE and a submission as required under 37 CFR 1.114. The previously submitted after-final amendment does not qualify as the required submission since this amendment was never entered, and Jones failed to submit a request with the RCE that the previously submitted after-final amendment be entered. Unlike CPA practice, if the RCE is not accompanied by the required submission and filing fee, the time period set in the last Office action (mailed on June 28, 2001) will continue to run. Since the time period expired on December 28, 2001, the application is abandoned. Accordingly, model answer (C) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 20 reads as follows:

20. J. Q. Practitioner represents the IMAKECOPY Corp., which is an importer of widgets into the USA. At the request of his client, J. Q. Practitioner is reviewing the prosecution history of a published patent application filed under 35 U.S.C. § 111, that contains process claims for making widgets and other claims directed to the widget products. The application lists Rob M. Blind as the inventor and Wesue Corp. as the assignee. Rob M. Blind is an employee of the Wesue Corp. which is a competitor of the IMAKECOPY Corp. The prosecution history of the published patent application contains a restriction

requirement made by the examiner followed by an election of the process claims by the applicant, and cancellation of the non-elected product claims. No related patent applications are referenced in the published patent application or its prosecution history. A search of public USPTO databases indicates no divisional patent application has been published or issued as a patent. J. Q. Practitioner wants to obtain more information concerning the cancelled product claims. Which of the following statements is true?

- (A) J. Q. Practitioner cannot obtain other information because no information about pending unpublished applications is available under 35 U.S.C. § 122, except for previously filed applications.
- (B) J. Q. Practitioner may obtain a copy of the originally filed application and a copy of all unpublished divisional applications containing the non-elected product claims.
- (C) J. Q. Practitioner may obtain a copy of all unpublished applications including their prosecution histories for any patent application containing the non-elected product claims.
- (D) J. Q. Practitioner may file a written request for the File Information Unit (FIU) to ascertain if there are any earlier or subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.
- (E) J. Q. Practitioner may request, either in person or in writing, that the File Information Unit (FIU) ascertain and disclose if there are any subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application and their status.

20. The model answer: The model answer is choice (E). 37 C.F.R. § 1.14(b)(4). MPEP § 102, "Information as to status of an Application." Under 37 C.F.R. § 1.14, the Office may provide status information for pending patent applications that claim the benefit of the filing date of an application for which status information may be provided. Hence information will only be available on this basis for subsequently filed applications. Answer (A) is incorrect because information may be available for subsequently filed applications. Answers (B) and (C) are incorrect because only status information, not copies of the application, are provided. Answer (C) is also incorrect because a claim for benefit under 35 U.S.C. § 120 must be made before status information will be provided. Answer (D) is incorrect because status information is only given for subsequently filed applications.

Petitioner argues that answer (A) is correct. Petitioner contends that J. Q. Practitioner cannot obtain other information because 35 U.S.C. § 122 (b) states: "No information concerning published patent applications shall be made available to the public except as the Director determines." Petitioner also contends that J.Q. Practitioner wants to gain information about the cancelled product claims, which would not be status information under 37 CFR 1.14(a)(1) and therefore would not be available.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that J. Q. Practitioner cannot obtain other information about pending applications, under 37 C.F.R. § 1.14(b)(4), the Office may provide status information for any subsequently filed applications claiming benefit under 35 U.S.C. § 120 of the published application, as discussed in the model answer. J.Q. Practitioner can determine, for example, if any subsequently filed applications claiming benefit under 37 U.S.C. § 120 of the published application, have recently been published. A review of a published, subsequently filed application (which need not be a divisional) may provide information concerning the cancelled product claims. Finally, note that the question asks: "Which of the following are true?". As stated in the directions to the morning and afternoon sections, petitioner must choose the answer that is *most correct*. For this question, answer (E) is not only the most correct answer, it is the only correct answer. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 32 reads as follows:

32. Johnnie owns a supermarket store in Cleveland, Ohio, and is constantly frustrated when little children drop their chewing gum on Johnnie's clean floor in the supermarket. In her spare time, Johnnie develops an entirely novel type of coating material that she applies to floor tile. The coating material resists adhesion to chewing gum. In order to check out the effectiveness of the floor tile coating material, on December 31, 2000, she secretly covers the floor tiles in her supermarket with the new chewing gum resistant floor tile coating material. Johnnie is amazed at the results inasmuch as cleaning the floor was never easier. On January 30, 2001, Johnnie, satisfied with the experimental use results, ceased testing the use of the coating material. The ability of the coating material to withstand chewing gum adhesion continued unabated throughout the remainder of 2001. On January 1, 2002, one of Johnnie's many customers, James, remarked at how clean the floor looked. Johnnie then told James of her invention. James thinks for one moment and suggests that the floor tile coating material may be useful in microwave ovens, so that food will not stick to the interior sides of the microwave oven. James discusses getting patent protection with Johnnie. Which of the following is true?

- (A) Johnnie could never be entitled to a patent on a floor tile in combination with a coating material affixed to the outer surface of the tile.
- (B) James can be named as a co-inventor with Johnnie in a patent application claiming a microwave oven wherein the internal surfaces of the oven are coated with the coating material.
- (C) Since for one year Johnnie told nobody that the floor tile in her supermarket contained the new chewing gum resistant coating material, she would never be barred from obtaining patent protection for the floor coating material.

(D) Use of the floor tile coating material in microwave ovens would have been obvious to one of ordinary skill in the art, since James thought of it within seconds after first learning of the floor tile coating material, and James was not skilled in the art.

(E) The floor tile having the coating material affixed to the outer surface of the tile, an article of manufacture, would not be patentable as of January 1, 2002 inasmuch as the article was in public use on the supermarket floor for one year.

32. The model answer: (B). Since Johnnie developed the material and James thought of the idea to use it in microwave ovens, they rightfully could be considered co-inventors of the new article of manufacture. As to (A) and (C), public use began on when the experimental use ended on January 30, 2001, and occurs even when the public is unaware that they were walking on the developed material since the material was used in a public place. As to (D), even though James only took a second to think of the idea, he is entitled to receive a patent unless it was obvious to one of ordinary skill in the art. Nothing in the prior art revealed that it was obvious to use the material in microwave ovens. As to (E), the article of manufacture is not barred even though the floor material itself cannot be patented. Johnnie conducted an experimental use of the article from December 31, 2000 through January 30, 2001. Thereafter, Johnnie had one year from the end date of the experimental use to file a patent application for the article. Johnnie may file a patent application before January 30, 2002.

Petitioner argues that answer (A) is correct. Petitioner contends that because Johnnie used the coating in public more than a year before applying for a patent, and since Johnnie left the coating material on the floor and it "continued unabated" after the experimentation which could be deemed to have ended on January 30, 2001, the invention would be barred under 35 U.S.C. 102(b). Petitioner assumes that an application was filed, and that the filing date was April 17, 2002 (the exam date). Based on that assumption, petitioner argues that it has been used in public for more than one year before the filing date, and is therefore barred by 102(b).

Petitioner's arguments have been fully considered but are not persuasive. As stated in the directions to both the morning and afternoon sections, petitioner must not assume any additional facts not presented in the questions. There is nothing in the question to indicate that a patent application has actually been filed. The question states only that James *discussed* patent protection with Johnnie. (A) is incorrect since Johnnie had one year from the end date of the experimental use to file a patent application for the floor tile in combination with a coating material affixed to the outer surface of the tile. Johnnie may file a patent application before January 30, 2002. Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 45 reads as follows:

45. Which of the following practices or procedures may be properly employed to overcome a rejection properly based on 35 U.S.C. § 102(e)?

(A) Persuasively arguing that the claims are patentably distinguishable from the prior art.

(B) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another."

(C) Filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent that either claims the same invention or claims an obvious variation of the subject matter in the rejected claim(s).

(D) (A) and (C).

(E) (A), (B) and (C).

45. The model answer: (E). See MPEP § 706.02(b) page 700-23 (8th ed.), under the heading "Overcoming a 35 U.S.C. § 102 Rejection Based on a Printed Publication or Patent." (A), (B), and (C) alone, as well as (D) are not correct because they are not the most inclusive.

Petitioner argues that answer (A) is correct. Petitioner contends that it is proper to persuasively argue that the claims are patentably distinguishable over the prior art.

Petitioner's arguments have been fully considered but are not persuasive. As stated in the directions to both the morning and afternoon sections, petitioner must choose the answer that is *most* correct. (A), (B), and (C) alone, as well as (D) are not the *most* correct because they are not the most inclusive. Petitioner is cautioned to read the directions carefully. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 3 reads as follows:

3. When filing a reissue application in November 2001 for the purpose of expanding the scope of the original patent claims, which of the following would not be in accordance with the USPTO rules of practice and procedure?

(A) The specification, including the claims, of the patent for which reissue is requested, must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.

(B) Applicant's intent to broaden the scope of the claims can be made known in a reissue application filed within 2 years of the patent grant date by presenting in the application when filed new or amended claims.

(C) Any amendments made to the original patent by physically incorporating the changes within the specification or by way of a preliminary amendment must comply with the revised amendment practice of 37 CFR 1.121(b) and (c) and include appropriate "clean" and "marked-up" versions of the paragraphs or claims being amended.

(D) Applicant's intent to broaden the scope of the claims can be made in a reissue application filed within 2 years of the patent grant date by specifying in the reissue declaration as one of the errors on which the reissue is based is that applicant claimed less than he had a right to claim.

(E) None of the above.

3. The model answer: The correct answer is (C). 37 C.F.R. § 1.173 and MPEP § 1453 both provide for making amendments in reissue applications. 37 C.F.R. § 1.121(h) refers reissue applicants to § 1.173 for making amendments in reissues. (A), (B), and (D) present proper USPTO procedures, and are therefore incorrect answers. (A) is incorrect as it is consistent with current filing requirements of 37 C.F.R. § 1.173 and MPEP § 1411. (B) is incorrect because it is consistent with the holding in *In re Graff*, 42 USPQ2d 1471, and MPEP § 1412.03. (D) is incorrect because 35 U.S.C. § 251 sets a two-year limit for filing broadened reissue applications. MPEP § 1414. (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that because answer (C) is in accordance with USPTO practice and procedure, (E) is correct. Petitioner argues that 37 CFR § 1.173(b) requires that the changes be shown by clean and marked-up versions.

Petitioner's arguments have been fully considered but are not persuasive. 37 C.F.R. § 1.121(h) refers reissue applicants to § 1.173 for making amendments in reissues. 37 CFR § 1.173(b) states "If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used." Similarly, 37 CFR § 1.173(b)(1)

requires that *changes to the specification must include markings pursuant to § 1.173(d)*. If markings pursuant to paragraph (d) are made, then the amendment is, in essence, a “marked-up” version. This differs from a “clean version”, in which any replacement or added paragraph(s) are added to the specification in clean form, and any rewritten or newly added claim must be in clean form, *without markings to indicate the changes that have been made*, as required by 37 C.F.R. § 1.121(b) and (c). A clean version is not required by 37 CFR § 1.173(b).

Furthermore, the revised amendment practice of 37 CFR § 1.121(b) and (c) requires that amendments be made by either an instruction to delete, add, or replace entire paragraphs, a replacement section in clean form, or a rewritten or newly added claim in clean form. This would not be in accordance with 37 CFR § 1.173(b), which states: “If amendment is made by an amendment paper, the paper must direct that specified changes be made.” If the amendment paper directs that specific changes be made, the specific changes to be made may be to any one line of a claim, or any one line of the specification, for example.

The revised amendment practice of 37 CFR § 1.121(b) and (c) is not in accordance with USPTO practice for making amendments in reissue applications. Accordingly, model answer (C) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. Patent practitioner files a patent application on behalf of inventors X, Y and Z. The patent application includes ten claims. X, Y and Z are joint inventors of the subject matter of claims 1-5. X and Y are joint inventor of the subject matter of claims 6-8. Y invented the subject matter of claim 9. Z is the inventor of the subject matter of claim 10. A patent examiner properly rejects independent claim 10 under 35 U.S.C. § 102(a) as anticipated by reference A, which is not a patent. In an attempt to overcome this rejection, a declaration that clearly antedates reference A is filed under 37 CFR 1.131. The declaration is signed by inventor Z, but not by X and Y. The declaration is:

(A) improper because all named inventors of an application must sign a declaration filed under 37 CFR 1.131.

(B) improper because the patent practitioner did not sign the declaration.

(C) proper if it shows that inventor Z is the sole inventor of the subject matter of claim 10.

(D) proper because 37 CFR 1.131 has no requirement on who must sign the declaration.

(E) proper because 37 CFR 1.131 only requires that the declaration be signed by an inventor named in the application.

6. The model answer: (C) is the most correct answer. MPEP § 715.04 pages 700-207 and 208 (8 th ed.), under the heading "WHO MAY MAKE AFFIDAVIT OR DECLARATION" states "[t]he following parties may make an affidavit or declaration under 37 C.F.R. [§] 1.131: ... (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection." In addition, 37 C.F.R. § 1.131(a) states "... the inventor of the subject matter of the rejected claim ... or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration..." Accordingly, answer (A) is incorrect because a declaration with less than all named inventors is acceptable when it is shown that less than all named inventors of an application invented the subject matter of the claim under rejection. Answer (B) is incorrect because the declaration was properly signed. Answer (D) is incorrect because 37 C.F.R. § 1.131(a) expressly provides for who must sign the declaration. Answer (E) is incorrect because it is the inventor of the subject matter of the claim under rejection who must sign the declaration, not any inventor named on the application.

Petitioner argues that answer (D) is correct. Petitioner contends that because 37 CFR § 1.131 states that the inventor of the rejected claim may submit a declaration, it is a reasonable interpretation that 37 CFR § 1.131 has no requirement on who must sign the declaration.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 37 CFR § 1.131 has no requirement on who must sign the declaration, 37 C.F.R. § 1.131(a) expressly provides for who must sign the declaration: the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47. A reasonable interpretation of the rule is that while any one of those listed *may* sign the declaration, at least one of them *must* sign it. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 9 reads as follows:

9. An applicant's claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.
- (E) None of the above.

9. The model answer: (D) is correct. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry's device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law." MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. "The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility." MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Larry's device does not teach away from a person of ordinary skill in the art combining it with Morris' device.

Petitioner argues that answer (A) is correct. Petitioner contends that since the answer choice states that the references by Larry and Morris cannot be physically combined, it is reasonable to read that choice as stating that the references would not be combinable. Petition further argues that the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle operation of the prior art. Finally, petitioner contends that the proposed modification would not have a reasonable expectation of success.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that choice (A) states that the references would not be combinable, choice (A) states that the references are not *physically* combinable. The question expressly states that the references are in fact combinable: "Although the examiner cites no suggestion or motivation for combining the references, *they are, in fact, combinable*" (emphasis added). Furthermore, the test of obviousness is not whether the features or elements of the references are physically combinable. One cannot argue, for example, that the peg of reference A is too large to fit into the hole of reference B. See MPEP 2145, under the heading "III. Arguing That Prior Art Devices Are Not Physically Combinable" (Eighth Edition, August 2001). "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review"). There is no mention in either the question or in the answer choices that the proposed modification renders the prior art unsatisfactory for its intended purpose, changes the principle operation of the device of the prior art, or fails to have a reasonable expectation of success. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

(A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.

(B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.

(C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8, of the preliminary amendment.

(D) All of the above.

(E) (A) and (B).

13. The model answer: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, "Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office..." Thus, choices (C) and (D) are incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that, during the recent tragedy of September 11, 2001 and the subsequent anthrax scare, the Office considered the state of preparation of a first Office action as of the certificate of mailing date under 37 CFR § 1.8. Petitioner also argues that the certificate of mailing under § 1.8 would be a factor when looking to 37 CFR § 1.115(b)(2) for entry of a preliminary amendment. Finally, petitioner argues that since 37 CFR § 1.115(b)(1)(i) utilizes the term "include" (i.e., "Factors. . . *include*" (emphasis added)), the list of factors included in this paragraph are non-exhaustive.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the Office considered the state of preparation of a first Office Action as of the certificate of mailing date during the aftermath of September 11, 2001, and the subsequent anthrax scare, the state of preparation as of the certificate of mailing date was not considered. 37 CFR § 1.115(b)(1)(i) states that the factors that will be considered in disapproving a preliminary amendment include "(t)he state of preparation of a first Office action *as of the date of receipt (§ 1.6)*" (emphasis added). § 1.6 does not include § 1.8 certificate of mailing dates. See also, for example, the notice appearing on the USPTO website, www.uspto.gov, under "Emergencies and Alerts", entitled "Processing of, and Requirements for, the Filing of Duplicate Applications and Papers in Patent Applications in view of USPS Mail Delays" (posted December 21, 2001). Under the heading "III. Establishing that a Paper Other than a Reply was Mailed to the USPTO", the notice states that "a preliminary amendment is not a reply to an Office action and, therefore, would not receive the benefit of a certificate of mailing under 37 CFR 1.8(a)". 37 CFR § 1.115(b)(2) states that the preliminary amendment will not be disapproved if it is filed no later than: (i) Three months from the filing date of an application under § 1.53(b). Paragraph (b) of this section, however, makes no mention of certificate of mailing dates. The date of filing of a preliminary amendment is the date of receipt in the Office under 37 CFR § 1.6 as specified in paragraph (a) of § 1.115. Finally, whether the list of factors specified in § 1.115(b)(1) is non-exhaustive is not relevant, since 37 CFR § 1.115(a) clearly specifies the relevant section (§ 1.6) under which the date of receipt in the Office of the preliminary amendment is determined. § 1.6 does not include § 1.8 certificate of mailing dates. Accordingly, model answer E is correct and petitioner's answer D is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. In early 1999, at the request of MC Motors, Eve demonstrated her reverse automobile heating system at a testing facility in Germany. MC Motors signs a confidentiality agreement and agrees not to disclose the invention to anyone. The test is conducted in a secluded area and the persons involved are sworn to secrecy. Unbeknownst to Eve, MC Motors installs the reverse heating system on its MC cars and begins selling its cars with the reverse heating system in the United States in September 1999. In August 2000, MC files a patent application in the United States for the reverse automobile heating system. In December 2000, Eve files a patent application claiming the automobile heating system. The examiner rejects all the claims in Eve's application based upon an MC Motors brochure advertising its cars in September 1999. Which of the following is true?

- (A) Eve is not entitled to a patent since the invention was on sale in this country, more than one year prior to the date of the application for patent in the United States.
- (B) Since the MC Motors misappropriated the invention and since Eve did not authorize the sale, the rejection may be overcome by showing that the sales by MC Motors were not authorized by Eve.
- (C) MC Motors is entitled to a patent since although it misappropriated the idea for the invention from Eve, the misappropriation was beyond the jurisdiction of the USPTO.
- (D) (A) and (C).
- (E) None of the above.

33. The model answer: (A) is the most correct answer. In *Evans Cooling Systems, Inc. v. General Motors Corp.*, 125 F.3d 1448, 44 USPQ 2d 1037 (Fed. Cir. 1997) the Federal Circuit held that even though an invention is misappropriated by a third party, the public sale bar applies (35 U.S.C. § 102(b)). Accordingly, (A) is true and (B) is not. (C) is incorrect since the people at MC were not the true inventors, and therefore, the misappropriation is within the jurisdiction of the USPTO. 35 U.S.C. § 102(f). (D) is incorrect inasmuch as (C) is incorrect. (E) is incorrect inasmuch as (A) is correct.

Petitioner argues that answer (D) is correct. Petitioner contends that (D) is correct because (A) and (C) are correct. Petitioner argues that (C) is also correct because misappropriation would be dealt with by a judicial proceeding, outside or concurrent with the USPTO's jurisdiction. Since the fact pattern does not state that the examiner knew of the misappropriation, petitioner contends, MC Motors would be entitled to the patent based on its application filed in August 2000.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the misappropriation is outside of the USPTO's jurisdiction, the misappropriation is within the jurisdiction of the USPTO because the people at MC were not the true inventors. See 35 U.S.C. § 102(f). Whether the examiner

would reject the claims under 35 U.S.C. 102(f) does depend on whether the examiner knew that the people at MC were not the true inventors, which is not specified in the fact pattern. Answer (C), however, states that MC Motors is *entitled to a patent*. Even if the examiner failed to reject the claims under 35 U.S.C. 102(f) because he was unaware of the misappropriation, and the application subsequently passed to issue, MC nevertheless would not factually be entitled to any patent that would issue. The patent would not be properly granted in such a case. Whether MC Motors is entitled to a patent does not depend, therefore, on whether the examiner knew that the people at MC were not the true inventors. Accordingly, model answer (A) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 37 reads as follows:

37. Applicant Einstein files a patent application on November 26, 1999, that claims a new type of football pads. Prosecution is conducted and the application issues as a patent to Einstein on April 3, 2001. A competitor, Weisman, who has been making and selling football pads since April of 1998, learns of Einstein's patent when Einstein approaches him on May 3, 2001, with charges of infringement of the Einstein patent. Weisman makes an appointment to see you to find out what he can do about Einstein's patent, since Weisman believes that he is the first inventor of the claimed subject matter. At your consultation on May 17, 2001, with Weisman, you discover that Weisman widely distributed printed publications containing a fully enabling disclosure of the invention and all claimed elements in the Einstein patent. Weisman used the printed publication for marketing his football pads in April of 1998. Weisman explains that he wishes to avoid litigation. Which of the following is a proper USPTO practice and procedure that is available to Weisman?

(A) Weisman should file a petition to correct inventorship under 37 CFR 1.324 in the patent, along with a statement by Weisman that such error arose without any deceptive intention on his part, requesting that a certificate of correction be issued for the patent under 35 U.S.C. § 256, naming the correct inventive entity, Weisman.

(B) Weisman should file a reissue application under 35 U.S.C. § 251, requesting correction of inventorship as an error in the patent that arose or occurred without deceptive intention, wherein such error is corrected by adding the inventor Weisman and deleting the inventor Einstein, as well as citing Joe Weisman's April 1998 printed publication for the football pads as evidence that Weisman is the correct inventor.

(C) Weisman should file a prior art citation under 35 U.S.C. § 301, citing the sales in April 1998 of football pads, and explain the pertinency and manner of applying such sales to at least one claim of the Einstein patent.

(D) Weisman should file a request for *ex parte* reexamination of the Einstein patent under 35 U.S.C. § 302, citing the April 1998 printed publication of football pads in, and explain the pertinency and manner of applying such prior art to at least one claim of the Einstein patent.

(E) Weisman should file a request for *inter partes* reexamination of the Einstein patent under 35 U.S.C. § 311, citing public use of the football pads in April 1998, and explain the pertinency and manner of applying such prior use to at least one claim of the Einstein patent.

37. The model answer: (D) is correct. It is the only answer that proposes to use a practice and procedure that is available to Weisman. 35 U.S.C. § 302. (A) This is incorrect because a statement by the currently named inventor as required by 37 C.F.R. § 1.324(b)(2) and the fee required by 37 C.F.R. § 1.20(b) have not been filed. (B) This is incorrect, as in *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 n.16, 195 USPQ 97, 106 n.16 (D.C. Cir. 1977) wherein correction of inventorship from sole inventor A to sole inventor B was permitted in a reissue application, does not apply here, as a reissue application can only be filed by the inventor(s) or assignee(s). See MPEP § 1412.04. (C) This answer is incorrect because it refers to sales, as opposed to patents or printed publications. (E) The option of requesting *inter partes* reexamination is not available in this scenario, as the patent in question issued from an original application which was filed prior to the critical date of November 29, 1999. Only patents which issued from original applications filed in the United States on or after November 29, 1999, are eligible for *inter partes* reexamination (37 C.F.R. § 1.913).

Petitioner argues that answer (C) is correct. Petitioner contends that Weisman could file a prior art citation under 35 U.S.C. § 301, citing the sales (and sales invoices relating to a product description, part number, and a catalogue) in April 1998 of football pads, and explain the pertinency and manner of apply such sales to at least one claim of the Einstein patent. Because the sales and "Weisman's widely distributed printed publications" are evidence of an "offer to sale", petitioner contends that Einstein would be barred under 35 U.S.C. § 102(b). Petitioner contends that raising this issue of a 102(b) on-sale bar would challenge Einstein's patent without going to litigation.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that Weisman could file a prior art citation under 35 U.S.C. § 301, citing the sales (and sales invoices), 35 U.S.C. § 301 only permits the citation of patents and printed publications, not sales figures and sales invoices (which are not printed publications).

Furthermore, petitioner is reminded that the Einstein's patent has already issued. While a *proper* submission (of either patents or printed publications) under 35 U.S.C. §

301 would be retained in the patented file, and would effectively put a cloud on the patent, no 35 U.S.C. 102(b) rejection would be made by the Office since prosecution of the patent application does not continue after the patent issues. A rejection under 35 U.S.C. 102(b) could be made, however, in an *ex parte* reexamination proceeding. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

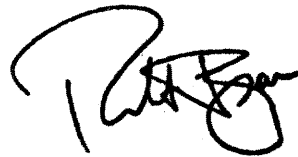
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy